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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,150	02/25/2002	Kyuichirou Nagai	62758-017	8786
7590 06/03/2004 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER ARNOLD III, TROY G	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,150

Applicant(s)

NAGAI ET AL.

Examiner

Troy Arnold

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Upon further consideration of the Drawings and the Specification, it appears that the Figures may be categorized in the following manner:

- ~ Figs 1-4 represent Prior Art, a product currently on the market - see page 4, lines 5 and 6 and line 19 of page 5 of the Specification, and also page 1 of the Response to Restriction Requirement;
- ~ Figs 5-11 represent Species I;
- ~ Figs 12-16 represent Species II, which has a different structure and different mode of use from Species I, Figs 15 and 16 are the same invention as Figs 12-14, they simply show one retention structure rather than two;
- ~ Figs 17 and 18 represent Species III, an entirely different invention from that shown in Figs 5-11 – it retains a disc by virtue of a flexible rear wall of the case.

Applicant's election with traverse of Species I in paper dated 27 February 2004 is acknowledged. The traversal is on the ground(s) that embodiments, not species, are disclosed, all of the claims read on the elected species, and that there is not an "unreasonable" number of species. This is not found persuasive because a) it is submitted that the patentably distinct species disclosed are noted as above, b) at least claims 12 and 13 do not read on the elected species shown in Figs 5-11, and c) Applicant is entitled to examination on one patentably distinct structure in the instant application.

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Contrary to the Applicant's remarks, claims 12 and 13 do not read on the elected species shown in Figs 5-11, and as such claims 12 and 13 are withdrawn from consideration.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

It appears Figs 1-4 are Prior Art (see page 4, lines 5 and 6 and line 19 of page 5). Therefore, figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

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Specifically, in claim 1, it is unclear whether or not a "disc-like recording medium" is being positively claimed and recited. For examination purposes, it is assumed a medium IS being claimed. In claim 1, the phrase "and deformed....recording medium" is unclear – what does it modify? Claim 2 is entirely vague and indefinite – it is not at all clear what is being claimed. Furthermore, there does not appear to be support in the specification for the subject matter of claim 2. Claim 3 is functional language, and recites no distinct limitations. In claim 9, is the "disc-like record media" a different structure from that already claimed? There is no antecedent basis for this limitation. The first part of claim 11 is functional language. In claim 14, it is unclear whether or not a "disc-like recording medium" is being positively claimed and recited. For examination purposes, it is assumed a disc is NOT being claimed. Claim 15 comprises only functional language, recites no distinct structural limitations, and as such is given little patentable weight. Claim 17 is a product-by-process claim that recites no distinct limitations as well.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 11 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman et al, US Patent No. 5,573,120. Regarding claim 1, Kaufman teaches a case 60 enclosing a disc-like recording medium 72, comprising an opening

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part 82 for exposing the medium 72 to the outside, and an elastic deformation part 74 of a cantilever structure holding the medium 74 and deformed in the direction of the thickness of the medium 74. See also column 2, beginning line 54. Kaufman teaches the limitations of claims 2, 5, 9 and 11, inasmuch as they are understood. Regarding claims 3 and 4, item 74 is deformed to take out the medium 72, and item 74 has a free end in the taking out direction. Regarding claim 6, the deforming part 74 is limited in its downward movement by the bottom portion of the case. Regarding claim 7, item 80 is a guide part with a slant face, which enters the thickness of the disc case. Regarding claim 8, item 80 has a regulating wall on the side which will position the disc in the radial and thickness directions. Regarding claim 14, Kaufman teaches a case 60 which is capable of enclosing a disc-like recording medium, comprising an opening part 82 for exposing the medium to the outside, and an elastic deformation part 74 of a cantilever structure holding the medium and deformed in the direction of the thickness of the medium. See also column 2, beginning line 54. Regarding claim 15, item 74 will be deformed to remove the disc. Regarding claim 16, item 74 has a free end in the direction of taking out the medium. Regarding claim 17, see column 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman. Regarding claim 10, it would be obvious to put any of a variety of differently-sized or configured discs in the case of Kaufman.

It appears that several other of the references teach similar structures which may meet the claimed limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Troy Arnold
Examiner
Art Unit 3728



Mickey Yu
Supervisory Patent Examiner
Group 3700

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TGA

5/27/04